

**Notice of Allowability**

Application No.

10/757,606

Applicant(s)

TALLEY ET AL.

Examiner

Robert Shiao

Art Unit

1626

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to responses filed on May 19, 2005.
2. ☒ The allowed claim(s) is/are 1-9 and 18-19, now are 1-11.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 05/05/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_



### **DETAILED ACTION**

1. This application claims benefit of the application: 10/004,960 with a filing date December 04, 2001.
2. Amendment of claims 1-9, cancellation of claims 10-14, addition of claims 18-24 in the amendment filed on May 19, 2005, is acknowledged. No new matter is found. Claims 1-17 and 18-24 are pending in the application.

### ***Responses to Amendment/Arguments***

3. The rejection of claims 2-9 under 35 U.S.C. 112, second paragraph, has been overcome in the amendment filed on May 19, 2005.
4. Applicant's arguments regarding rejection of 1-6, and 10 under 35 U.S.C. 102(a) filed on May 19, 2005, have been fully considered and they are persuasive. The instant priority date of application No. 08/460,324 (now is US 5,643,933) is June 2, 1995, which is prior to the prior art, Numata et al. WO 9614302, published on May 17, 1996. Therefore, rejection of claims 1-6, and 10 under 35 U.S.C. 102(a), is withdrawn herein.

### ***EXAMINER'S AMENDMENT***

5. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee. Authorization for this examiner's

amendment was given in a telephone interview with Philip B. Polster on July 05, 2005.

The application has been amended as follows:

Delete claims **15-17** and **20-24**

### ***Reasons for Allowance***

6. The following is an examiner's statement of reasons for allowance:

Claims 1-9 and 18-19 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to substituted sulfonylphenyl-heterocycles as cyclooxygenase-2 and 5-lipoxygenase inhibitors. The closest reference is Talley et al. US 6,677,364, which is the parent case, discloses substituted sulfonylphenylheterocycles as cyclooxygenase-2 and 5-lipoxygenase inhibitors. The difference between Talley et al. '364 and instant claims is that the instant compounds are not claimed in Talley et al. Suggestion for modification of above record to obtain the instant claimed compound, has not been found. Claims 1-9 and 18-19 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusions***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.


Art Unit: 1626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TAOFIQ SOLOLA  
PRIMARY EXAMINER



Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626



Robert Shiao, Ph.D.  
Patent Examiner  
Art Unit 1626

July 13, 2005